

REMARKS

Claims 1-24 are pending in the above-identified application. Claims 1-24 were rejected. Claims 9 and 16 are objected to. With this Amendment, claims 9-16 were amended. Accordingly, claims 1-24 are at issue.

I. Objections to claims

Claims 9 and 16 were objected to because of informalities. This Amendment amends claims 9 and 16 to address the issues raised by the Examiner.

II. 35 U.S.C. § 101 Indefiniteness Rejection of Claims

Claims 9-15 were rejected under 35 U.S.C. § 101. This Amendment amends claims 9-15 to address the issues raised by the Examiner.

III. 35 U.S.C. § 112 Indefiniteness Rejection of Claims

Claims 1-8 and 17-24 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse this rejection.

The Examiner asserts that the text “modifying said original document on said disconnected device to form a modified document” is indefinite because “a computer or any computer-based device, when disconnected that means unplugged, can not load documents to modify.” The Examiner appears to be misinterpreting the term “disconnected device.” The specification defines the term “disconnected device” and enables the step of transferring an original document from a computer to a disconnected device. See, for example, page 2, lines 15-21 and Figure 8.

IV. 35 U.S.C. § 103(a) Obviousness Rejection of Claims

Claims 1-3, 5-11, 13-19, and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,272,485 ("Sragner"). Applicants respectfully traverse this rejection.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143.

Regarding claim 1, the Examiner's rejection under § 103(a) is improper for at least two reasons. First, Sragner does not teach or suggest all the claim limitations. Second, the Examiner has not provided any suggestion or motivation to modify Sragner to include the missing limitations.

First, Sragner does not teach or suggest a "disconnected device." The Examiner asserts that "the computer at the remote terminal, when unplugged or turned off is considered as a disconnected device while the original is transferred to it." Applicants respectfully disagree with the Examiner's characterization of the remote terminal as a "disconnected device." The remote terminal in Sragner cannot be a "disconnected device." See, for example, page 2, lines 15-18 of the specification.

Sragner also does not teach or suggest determining one or more modifications between the original document and the modified document. The Examiner appears to acknowledge this on page 5 of the Office action when the Examiner asserts "Sragner does not explicitly disclose determining one or more modifications between said original document and said modified document." Though the Examiner admits that Sragner does not teach this limitation, the Examiner fails to offer a secondary reference or teaching that provides this limitation. Instead the Examiner asserts "Sragner discloses that the present invention as well as the various embodiments of the invention include methods and systems which send documents from the central server to a remote user where the user can modify the received documents and return to the central server." Office action, p. 5. The Examiner further asserts "the fact that entering data into the data field of the received document, which is the original document, shows one modification between the original document and the modified document." Office action, p. 5.

This teaching by Sragner of modifying a document by entering data into a data field does not teach or suggest determining one or more modifications between an original document and a modified document. Determining a modification involves, for example, different methods, software, and resources than simply creating a modification. The differences between the two steps are further illustrated by claim 1 which contains two distinct limitations directed to the two steps.

In addition to not providing references that teach or suggest all the claim limitations, the Examiner fails to provide a suggestion or motivation to modify Sragner. According to the Examiner, "It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Sragner to include determining one or more modification between said original document and said modified document since the fact that entering data into the data field of the received document, which is the original document, shows one modification between the original document and the modified document.”

Applicants submit that one would not be motivated to modify Sragner based on “the fact that entering data into the data field of the received document, which is the original document, shows one modification between the original document and the modified document.” Modifying an original document does not provide any reason to add an additional step of determining a modification. Sragner does not teach any benefits to be gained from adding such a step, Sragner does not teach any way that such a step could be implemented, and Sragner does not teach why a user might want to perform a step of determining a modification. If the Examiner continues to assert that Sragner’s teachings somehow motivate one of ordinary skill to add a step of determining modifications, Applicants respectfully request that the Examiner explain where Sragner teaches the desirability of modifying the reference.

Claims 9 and 17 are not unpatentable over Sragner for at least the same reasons that claim 1 is not unpatentable over Sragner. Claims 2, 3, and 5-8 depend from claim 1 and are therefore not unpatentable over Sragner for at least the same reasons. Claims 10, 11, and 13-16 depend from claim 9 and are therefore not unpatentable over Sragner for at least the same reasons. Claims 18, 19, and 21-24 depend from claim 17 and are therefore not unpatentable over Sragner for at least the same reasons.

Claims 4, 12, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,485 ("Sragner") in view of U.S. Patent. No 6,356,961 ("Oprescu-Surcobe"). Claims 4, 12, and 20 depend upon claims 1, 9, and 17 respectively and are therefore not unpatentable over Sragner in view of Oprescu-Surcobe for at least the same reasons.

V. Conclusion

In view of the above amendment and remarks, Applicants submit that all claims are allowable over the cited prior art, and respectfully request early and favorable notification to that effect.

Respectfully submitted,

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